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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,564	11/26/2003	Wayne Edward Beimesch	414130	9670
30954	7590	09/28/2005	EXAMINER	
LATHROP & GAGE LC 2345 GRAND AVENUE SUITE 2800 KANSAS CITY, MO 64108			ROGERS, DAVID A	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,564	Applicant(s) BEIMESCH, WAYNE EDWARD	
	Examiner David A. Rogers	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12 September 2005 have been fully considered but they are not persuasive.

The applicant's arguments regarding the rejection of claims 11-22 under 35 USC 103(a) have been addressed in the previous office action.

The applicant's arguments regarding the rejection of claims 23-31 is moot as a new ground for rejection has been provided.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23-31 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent 5,140,845 to Robbins.

Robbins discloses a sealable bag (reference item 120) for holding material containing volatile organic compounds (VOCs). Robbins also discloses instructions for sampling and analyzing, i.e. the patent itself clearly discloses how to sample and analyze the sample for VOCs. Therefore, the patent, in combination with the sealable bag, forms a kit. With regard to claims 23-31

the specific written material in the instructions describing the methods are not given any patentable weight.

With regard to instructions the applicant is directed to *In re Ngai*, 70 USPQ2d 1862. In *Ngai* the claim under appeal was rejected under 35 USC 102(b) and was directed to a kit comprising a premeasured portion of material and instructions to perform a method. The prior art taught a kit having the material and instructions (albeit different instructions from those being claimed). In *Ngai* the Court of Appeals for the Federal Circuit (CAFC) expressly stated that “the claim [of *Ngai*] does not set forth any functional relationship between the instructions and the buffer [the material] that would distinguish the claimed buffer from those taught by Stratagene.” The CAFC went on to quote the CCPA in *In re Pearson* stating “terms that merely set forth the intended use for...an otherwise old composition...do not differentiate the claimed composition from those known in the prior art” and “[i]t seems quite clear to us that one of the compositions admitted to be old by the applicant would not undergo a metamorphosis to a new composition by labeling its container to show that it is a composition suitable for [another use].” It is clear from *Ngai* that the addition of new instructions to a known kit merely teaches a new use for an existing product.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Compilation of Air Pollutant Emission Factors, AP-42" to the Environmental Protection Agency (EPA) in view of United States Patent 5,140,845 to Robbins, United States Patent 5,809,664 to Legros *et al.*, and "Chemical Principles" to Masterton *et al.*

The EPA continually promulgates information and guidance to the public regarding hazardous materials. Of particular relevance is EPA Method AP-42. Section 6.8 of this method, written July 1993, addresses soaps and detergents. Herein the Method AP-42 reiterates what the applicant already admits is well-known, and that is that certain processes such a spray drying release VOCs into the atmosphere. Furthermore, section 6.8.3.1 of Method AP-42 states (emphasis added)

The main atmospheric pollution problem in soap manufacturing is odor. The storage and handling of liquid ingredients (including sulfonic acids and salts) and sulfates are some of the sources of this odor. Vent lines, vacuum exhausts, raw material and product storage, and waste streams are all potential odor sources. Control of these odors may be achieved by scrubbing exhaust fumes and, if necessary, incinerating the remaining volatile organic compounds (VOC).

In section 6.8.3.2 it is stated (emphasis added):

In addition to particulate emissions, volatile organics may be emitted when the slurry contains organic materials with low vapor pressures. The VOCs originate primarily from the surfactants included in the slurry. The amount vaporized

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depends on many variables such as tower temperature and the volatility of organics used in the slurry. These vaporized organic materials condense in the tower exhaust airstream into droplets or particles. Paraffin alcohols and amides in the exhaust stream can result in a highly visible plume that persists after the condensed water vapor plume has dissipated.

Opacity and the organic emissions are influenced by granule temperature and moisture at the end of drying, temperature profiles in the dryer, and formulation of the slurry. A method for controlling visible emissions would be to remove offending organic compounds (i. e., by substitution) from the slurry. Otherwise, tower production rate may be reduced thereby reducing air inlet temperatures and exhaust temperatures. Lowering production rate will also reduce organic emissions.

The Method AP-42 is quite clear that the temperature of the process may, in fact, be a major causal factor in the release of VOCs into the atmosphere. Furthermore, drying towers, vent lines, product storage (i.e. storage tanks), vacuum exhausts, and waste streams are all regions within a process system whose temperature can be measured.

Section 7.1 of Method AP-42 details VOC emissions from systems such as storage tanks. This section also provides a listing of some known VOCs and their boiling points and vapor pressures (see table 7.1-3). This section also provides a detailed example on estimating the emission rate of VOCs from the material in a storage tank (see pages 7.1-73 through 7.1-83). This estimating process clearly shows that the emission rate is a function of the temperature of the material in the tank, the vapor space volume, and the equilibrium partial pressures of the volatile organic liquids in the material.

Robbins teaches a method and apparatus for measuring volatile organic compounds (VOCs) in soils. In particular, Robbins teaches a resealable polyethylene bag (reference item 120) into which is placed a sample (an aqueous sample or a soil sample mixed with distilled water) (column 3, lines 35-37). After sealing, the bag is agitated to promote the release of any VOCs present in the sample. Robbins further reiterates what is already well-known in the art by citing from “Water Quality” to Tchobanoglous. This citation, generally on column 2, lines 55-68 and column 3, lines 1-7, teaches that time, mass size, and temperature all directly affect headspace equilibrium. At any rate, Robbins teaches that the headspace in the sealed bag is to reach equilibrium prior to testing for VOCs. In testing for VOCs, Robbins teaches that a flame ionization detector (FID) is used as the means to detect the VOCs in the headspace.

Robbins teaches that it is beneficial to store the bag at an optimum temperature in order that the headspace reach a state of equilibrium (column 5, lines 1-6). Robbins also teaches that time is a relevant factor to reach the desired equilibrium in the headspace (column 4, lines 57-58). Finally, Robbins teaches that the initial mass of the sample is directly related to the measured equilibrium headspace concentration (equation 5, equation 7). Robbins does not expressly teach a method for testing where the material is placed in a sealable bag and is stored at the mean exit temperature of said emissions of said system.

Masterton *et al.* teaches the general scientific theory of liquid-vapor equilibrium in a closed system. A sealed flask is used in the example, but the scientific principles apply equally to a sealed bag. Masterton *et al.* teaches that a liquid placed in the closed system will, over time, reach a state of equilibrium with regard to the headspace. Equilibrium is the state wherein, at a given temperature, the number of molecules from the liquid entering into the vapor state (headspace) equals the number of molecules reentering the liquid state. As temperature increases the vapor pressure of liquids increase. Therefore, at higher temperatures a larger fraction of molecules will acquire enough energy to escape from the liquid to the vapor. This means that at higher temperatures more vapor molecules will be present in the headspace than at lower temperatures. Equilibrium, however, will be reached over time and will be independent of the temperature. It is just that more molecules will be present in the vapor when equilibrium is reached at higher temperatures thus increasing the probability of detection of the VOC molecules when the headspace is sampled.

Replicating the conditions that exist in a product manufacturing process, e.g. replicating the temperature at which products are manufactured, stored, or handled, etc. would allow one of ordinary skill to determine if the specific conditions was indeed causing VOCs to be released into the atmosphere. Since vapor pressure of liquids increases with temperature, VOC release rates will be higher at points in the manufacturing process that are at elevated

temperatures. These increased release rates must be monitored to ensure that the manufacturing process is in compliance with state and federal laws that require monitoring of VOCs (see also applicant's background of the invention). By understanding this basic relationship between temperature and vapor pressure one could then use techniques to minimize the amount of VOCs released, such as by scrubbing, incineration, substitution, and lower temperatures. See again section 6.8.3.1 of Method AP-42.

It is important to note that maintaining the closed system, i.e. the sealed bag, at the "mean exit temperature" of the process may be impractical. Bed dryers and spray dryers can operate at very high temperatures that would cause the bag to melt. See Legros *et al.* where it is taught that it is known that fluid bed dryers can operate at 400 °C and are a source of VOCs. Since Masterton *et al.* teaches that headspace equilibrium will eventually be reached independently of the temperature it will not be necessary to maintain the bag at such high temperatures. A higher temperature may be preferred since it will increase the amount of VOCS released into the headspace thus replicating existing processes and increasing the probability of VOC detection by the analyzing apparatus. That is, maintaining the temperature of the bag at an elevated temperature will also allow a facility to determine if their specific process has a higher-than-allowed release rate of VOCs. It is also important to note that, with open systems such as spray dryers and FBDs, VOCs will inherently release into the atmosphere even if the exit temperature was low.

This is because all liquids have a vapor pressure that is temperature dependent as noted above. A lower the temperature generally results in a lower emitting rate of a VOC. This can be seen in table 7.1-3 of the Method AP-42.

EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* and teaches that it is known that, in a closed system, the initial mass and the temperature affect the equilibrium. The time to reach equilibrium is, therefore, dependent on amount of material, the temperature of the material, and the vapor pressure of the materials of interest. The time for reaching equilibrium, e.g. time between 5 and 24 hours, therefore, is dependent on knowing the conditions (temperature, sample size) being tested and would be determined on a case-by-case basis.

It is also known that gas chromatographs (GC) and FIDs are used to determine analyte quantities in a sample based on the peak value, i.e. the measured response of the GC/FID. Specifically, a higher VOC concentration in the headspace, resulting from reaching equilibrium at elevated temperatures, will be reflected in the response from the GC/FID.

Finally, the applicant's choice of sampling materials from a fluid bed dryer (FBD) or spray bed dryer is anticipated by the fact that the applicant admits that "VOC measurement techniques have been developed and have been constantly employed to monitor VOC emissions of virtually every unit operation in every manufacturing facility throughout the world." According to the applicant's own admission, therefore, it is known in the art to measure

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VOCs in every manufacturing facility in the world, and this would include facilities with storage tanks, spray bed dryers, and fluid bed dryers. See also the pertinent prior art listed below.

In summary:

- a) EPA Method AP-42 teaches that manufacturing processes, including spray dryers and storage areas, may produce VOCs, and these VOCs may be released into the atmosphere;
- b) EPA Method AP-42 teaches that the amount of VOCs released into the atmosphere is dependent on the temperature;
- c) Robbins teaches that it is known to detect the presence of VOCs by obtaining a sample of material, placing the sample in a bag, sealing the bag, and then maintaining the bag at conditions to allow the headspace to reach equilibrium;
- d) Robbins teaches that it is known to use FID to measure the concentration of VOCs in the headspace of the sealed bag.
- e) Masterton *et al.* teaches that, in a sealed system, equilibrium will be reached in the headspace of the closed system independently of the temperature

and

- f) Masterton *et al.* teaches that the concentration of materials in the headspace is dependent on the temperature of the closed system.

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of EPA Method AP-42 with the teachings of Robbins, Legros *et al.*, and Masterton *et al.* in order to provide a sample of material from a system (spray dryer, storage tank, etc.), seal the material in a bag in order to have a headspace, and then to hold the material at a mean exit temperature of the emissions of the system in order to allow the

headspace to come to equilibrium prior to testing for the presence of VOCs using techniques such as a flame ionization detector.

6. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPA Method AP-42 in view of Robbins. Legros *et al.*, and Masterton *et al.* as applied to claims 11-13 above, and further in view of United States Patent 5,522,271 to Turriff *et al.* and/or "Method 5035 - Closed-System Purge-and-Trap and Extraction for Volatile Organics in Soil and Waste Samples" to the EPA.

EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* teaches that it is known to place material in a sealed bag and to let the headspace in the bag reach equilibrium prior to sampling for the presence of VOCs. Furthermore, Robbins teaches that, in headspace sampling, a consistent volume or weight of ground water or soil is placed in a container (column 1, lines 48-50) and the initial mass of the sample is critical to headspace equilibrium (columns 5-6). EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* does not expressly teach a sample size between 1 gram and 100 grams.

Turriff *et al.* teaches an apparatus for obtaining samples for VOC testing. The sampling device has a volume capacity of 25-30 grams (column 2, lines 64-67) and provides for the consistent volume for headspace sampling as required by Robbins. Also, EPA Method 5035 was originally promulgated by the EPA in 1996. This method specifically teaches methods for testing of VOCs in solid

materials such as soils, sediments, and solid wastes. This method can be used in conjunction with EPA Method 8015 which is testing using gas chromatographs and FIDs. Specifically, this EPA method teaches that VOCs are determined by collecting an approximately 5 gram sample and placing it in a vial with a septum-sealed screw-cap. The vial is sealed and shipped to a laboratory or appropriate analysis site. The entire vial is then placed, unopened, into the instrument carousel. The vial containing the sample is heated to 40 °C and the volatiles purged into an appropriate trap using an inert gas combined with agitation of the sample.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* with the teachings of Turriff *et al.* and/or Method 5035 in order to provide a apparatus as part of the method to obtain a sample size between 1 and 100 grams in order that the consistent sample size is placed in the bag prior to sealing.

7. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* as applied to claims 11-13 above, and further in view of “Determination of Volatile Organic Solvents in Water by Headspace Sampling with the 8200 CX Autosampler” to Penton.

EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* teaches that it is known to provide a sample in a sealed bag (a closed system)

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and to heat the bag so that the headspace reaches equilibrium. EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* further teaches that temperature affects the release of VOCs from a material. EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* does not teach a method where the material is held at a temperature between 5 °C and 100 °C.

Penton teaches that it is known in headspace sampling to maintain the closed system, i.e. the 22 mL vial with 10 mL sample, at 80 °C until headspace equilibrium is reached. Again, as known from Masterton *et al.*, equilibrium would have been obtained at any temperature. However more molecules will be released to vapor form at the higher temperature. This will increase the probability of detecting the VOCs in the sample.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of EPA Method AP-42 in view of Robbins, Legros *et al.*, and Masterton *et al.* with the teachings of Penton in order to provide a closed system (sealed bag) at a temperature between 5 °C and 100 °C in order to reach equilibrium in the headspace.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Rogers whose telephone number is (571) 272-2205. The examiner can normally be reached on Monday - Friday (0730 - 1600).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


22 September 2005


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